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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,656	02/13/2002	Hubert Baumgart	IN-5554	7707

26922 7590 01/16/2007

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EXAMINER	
SERGENT, RABON A	
ART UNIT	PAPER NUMBER
1711	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/049,656	BAUMGART ET AL.	
	Examiner	Art Unit	
	Rabon Sergent	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21,23,25-37,42 and 43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21,23,25-37,42 and 43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 21 and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 778924.

The reference discloses polymeric compounds produced from 3,6-diethyl-1,8-octanediol. See page 4, lines 55 and 75-85. Despite applicants' remarks, the position is taken that the skilled artisan would immediately envisage the use of the saturated diethyloctanediol within the disclosed polymers at page 4, lines 75-85. Despite applicants' argument, the position is maintained, in view of a polymer's definition requiring repeating units and the fact that

polymers, such as polyesters, are derived from repeating polyol monomer units, that the disclosed polymers (i.e.; the polyesters at page 4, line 76) inherently satisfy the argued "two or more monomer units" language. Despite applicants' arguments, the language, "these glycol products", at page 4, line 75 is considered to encompass the disclosed 3,6-diethyl-1,8-octanediol species. The examiner finds no convincing rationale why this species should be excluded from the aforementioned "glycol products". Additionally, to the extent that the meaning of "curable" is understood, the position is taken that the disclosed "drying oil" types of polyesters satisfy applicants' requirement that the composition be "curable" and contain the argued units. To the extent claimed, it is not seen that "curable" conveys any specific limitation to the claims other than requiring that the composition be able to be cured in some fashion.

3. Within polymeric systems, it is uncommon for weight average molecular weights and number average molecular weights to be equivalent; therefore, it is common for the polydispersity of such systems to exceed unity, often by a considerable margin; therefore, though the relied upon reference fails to specifically recite applicants' claimed polydispersity range, the position is taken in view of the breadth of the claimed range and the preceding rationale that the claimed polydispersity range is inherently met by reference.

4. Claims 21, 23, 25-37, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 778924.

As aforementioned, the reference discloses the use of diethyloctanediol in the production of polymers, including polyesters and polyurethanes suitable for use as coatings and adhesives.

5. Though the reference fails to disclose each of applicants' claimed isomers, the position is taken that it would have been obvious to utilize any isomer of diethyloctanediol in the production

of polymers, based upon the teachings of the reference. The basis for this position resides with the expectation that compounds that have a close structural similarity possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978). This position is bolstered by the fact that the utility and function of the argued compounds within polymerization reactions were well understood; therefore, the skilled artisan would have had a reasonable expectation of success in substituting one compound for another.

6. Applicants' response has been considered; however, the position is taken that the examiner has set forth a logical rationale as to why the disclosed composition is believed to inherently possess applicants' claimed polydispersity. Therefore, the burden has been shifted to applicants to explain why the disclosed compositions do not possess the claimed polydispersity, and the position is taken that applicants have failed to meet this burden.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
January 7, 2007

RABON SERGENT
PRIMARY EXAMINER